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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,999	07/30/2003	Richard Bodin	22171.353	7723
27683 7590 12/12/2007 HAYNES AND BOONE, LLP 901 Main Street Suite 3100 Dallas, TX 75202			EXAMINER ZAIDI, SYED	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,999

Applicant(s)

BODIN ET AL.

Examiner

Syed Zaidi

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/01/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date JAN 24 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed October 1st, 2007 have been fully considered but they are not persuasive.

Consider claim 1, Applicant argues, on page 8 of the remarks that **Ejzak et al.**, "**establishing a circuit bearer connection between the mobile device and network**". The Examiner respectfully disagrees with Applicant's argument because as recited in the above rejection, **Ejzak et al.**, suggests a transmission system (in figure 1) with a capability to a circuit bearer path 182 in a network extends between mobile device 140a and PSTN 132 (column 11 Lines 8-20). The MG 150 acts as a vocoder, translating bearer traffic between the packet wireless system and the circuit land-side network PSTN 132 and further, **Ejzak et al.**, show network communication established between the wireless terminal to the configuration of which is best seen in figure # 3. A circuit bearer path 380 extends between terminal 140c and MSC 124. A circuit bearer path 382 extends between MSC 124 and PSTN 132 (column 12 Lines 62-65 and fig 3).

The applicants argue that *neither Ejzak et al., nor Mo et al.,* teach “**the network does not support the required QoS functionality.**” The examiner respectfully disagrees with such findings. For the purpose of clarification, **Mo et al.** disclose that initial IP design on asynchronous data transfers largely ignored QoS for VoIP (column 1 lines 33-36). Therefore, **Mo et al.** evidently show there are network systems that do not support QoS and still allows mobile devices to communicate to one another.

Applicant argues, on page 10 of the remarks, that consequently, **Mo wholly fails** to describe or suggest a method of "transferring data for the multimedia service via the circuit bearer connection" that has had signaling information transferred "via the packet signaling connection" **Ejzak et al.**, the primary reference teaches (column 12 Lines 62-65 and fig 3).

The Applicants argues on page 16 that **Surdila et al, did not** teach claim invention. The Examiner respectfully disagree with applicant's argument because as recited in the rejection. Thus, In the present case, the **Surdila et al.**, reference discloses only mobile stations (Paragraph 0009, lines 3-5 and figure #1) capable of one of a packet-switched (Paragraph 0005, lines 5-10 and figure #1) operation

or a circuit-switched (Paragraph 0004, lines 1-5 and figure #1) operation. Thus **Surdila et al.**, is directed to a system in which the establishment of both a packet signaling connection and a circuit-switched bearer (Paragraph 0004, lines 10-14 and figure #1) connection with a common mobile station is neither described or suggested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 8, are rejected under **35 U.S.C. 103(a)** as being unpatentable over **Ejzak et al.** (U.S. Patent Application # 6,721,565 B1) in view of **Mo et al.** (U.S. Patent Number: US 7,177,304 B1).

Consider claim 1, Ejzak et al. clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, wherein the service is defined by a telecommunications standard, and wherein the network does not support packet quality of service (QoS) functionality as required by

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the standard the method comprising: establishing a packet signaling connection between the mobile device and network (Column 7 line 11-21) establishing a circuit bearer connection between the mobile device and network (Column 11 line 7-22 and figure 1 and elements 122 and 142); transferring signaling information for the multimedia service via the packet signaling connection in alignment with the standard (Column 4 line 7-10 and figure 1 elements 132, 150) and transferring data for the multimedia service via the circuit bearer connection in alignment with the standard (Column 7 line 11-21) wherein the multimedia service is provided to the mobile device via the network as specified by the standard even though the network does not support the required QoS functionality. However **Ejzak et al.** fail to teach the method ignored the required QoS functionality.

Nevertheless in the same field of endeavor, **Mo et al.**, support and show does not support the required QoS functionality (Column # 1 and lines 35-38).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate not executing at the required QoS functionality resources as taught by

Mo et al. in the method of **Ejzak et al.** for the purpose of signaling protocol ignoring the QoS functionality.

Consider claim 8, Ejzak et al. clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, wherein the service is defined by a telecommunications standard, and wherein the network does not support packet quality of service (QoS) functionality as required by the standard the method comprising: establishing a packet signaling connection between the mobile device and network (Column 7 line 11-21) establishing a circuit bearer connection between the mobile device and network (Column 11 line 7-22 and figure 1 and elements 122 and 142); transferring signaling information for the multimedia service via the packet signaling connection in alignment with the standard (Column 4 line 7-10 and figure 1 elements 132, 150) and establishing a packet-based signaling context between the endpoint and a gateway (Column 11 line 7-23) establishing a circuit bearer leg between the endpoint and the gateway using the signaling context (Column 12 line 57-64) and controlling the transfer of data via the circuit bearer leg using the signaling context, wherein the signaling

context is used to control the provision of the packet-based multimedia service via the circuit bearer leg in alignment with the standard (Column 13 line 46-53). However **Ejzak et al.** fail to teach the method ignored the required QoS functionality.

Nevertheless in the same field of endeavor, **Mo et al.**, support and show does not support the required QoS functionality (Column # 1 and lines 35-38).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate not executing at the required QoS functionality resources as taught by **Mo et al.** in the method of **Ejzak et al.** for the purpose of signaling protocol ignoring the QoS functionality.

1 - Ejzak
nmo
2

Claims 2-7 and 9-14, are rejected under **35 U.S.C. 103(a)** as being unpatentable over **Ejzak et al.** (U.S. Patent Application # 6,721,565 B1) in view of **Ahmavaara**. (U.S.Pub Number: US 2005/0101245 A1).

where mo?

Consider claim 2, and as applied to claim 1 above, **Ejzak et al.** as modified by **Ahmavaara**. disclose the claimed invention except further comprising executing at least one null operation to

xmo

authorize QoS resources wherein the operation is null because no QoS is requested due to the circuit bearer connection.

Nevertheless in the same field of endeavor, **Ahmavaara** executing at least no null operation to authorize QoS resources (Paragraph 0130, 01359 and figure # 14, # 15) wherein the operation is null because no QoS is requested due to the circuit bearer connection (Paragraph 0093).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the executing at least one null operation to authorize QoS resources wherein the operation is null because no QoS is requested due to the circuit bearer connection as taught by **Ahmavaara** for the purpose of signaling protocol providing the signaling functionality.

^{^ ~ 0}
Consider claim 3, Ejzak et al. as modified by Ahmavaara.
and applied to claim 1 above, clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network disclose the claimed invention except further comprising controlling the transfer of data via the circuit bearer connection using

the signaling information (Column 4 line 7-10 and figure 1 and element 132).

Consider claim 4, Ejzak et al. as modified by Ahmavaara.
clearly show and applied to claim 1 above, disclose a method for providing a packet-based multimedia service to a mobile further comprising requesting the circuit bearer connection, wherein the request is initiated by the network (Column 11 line 51-59).

Consider claim 5, Ejzak et al. as modified by Ahmavaara.
clearly and applied to claim 1 above, show and disclose a method for providing a packet-based multimedia service to a mobile device in a network, further comprising requesting the circuit bearer connection, wherein the request is initiated by the mobile device (Column 9 line 14-20).

Consider claim 6, Ejzak et al. as modified by Ahmavaara.
clearly shows and applied to claim 1 above, discloses a method for providing a packet-based multimedia service to a mobile device in a

network, further comprising maintaining the circuit bearer and packet signaling connections simultaneously (Column 5 line 24-29).

Consider claim 7, Ejzak et al. as modified by Ahmavaara.

clearly show and applied to claim 1 above, disclose a method for providing a packet-based multimedia service to a mobile device in a network, further comprising bridging the circuit bearer connection with an endpoint bearer connection, wherein the bridging establishes a link between the mobile device and the endpoint bearer connection (Column 11 line 7-23).

Consider claim 9, and as applied to claim 8, Ejzak et al. as modified by Ahmavaara. clearly show and disclose a method for providing a packet-based multimedia service to a mobile device in a network, further comprising initiating the establishment of the circuit bearer leg by either the endpoint or the gateway (Column 11 line 7-23) (Column 15 line 58-65).

Consider claim 10, and as applied to claim 8, Ejzak et al. as modified by Ahmavaara. clearly shows and discloses a method for

providing a packet-based multimedia service to a mobile device in a network, further comprising authorizing a previously requested QoS resource wherein the authorization is null because no QoS is requested due to the circuit bearer connection (Column 11 line 7-23).

Consider claim 11, and as applied to claim 8, **Ejzak et al.** as modified by **Ahmavaara**. clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, the method of claim 10 wherein the authorizing utilizes a packet control function (Column 15 line 58-65).

Consider claim 12, and as applied to claim 8, **Ejzak et al.** as modified by **Ahmavaara**. clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, the method of claim 8 wherein establishing the signaling context includes providing a codec indicating that a circuit bearer is being used (Column 2 line 22-30) (Column 4 line 7-10 and figure 1 and element 132).

Consider claim 13, and as applied to claim 8, **Ejzak et al.** as modified by **Ahmavaara**. clearly show and disclose a method for providing a packet-based multimedia service to a mobile device in a network, the method of claim 8 wherein establishing the signaling context includes provisioning the endpoint with a null codec to prevent voice packets from being sent via an available packet signaling connection (Column 2 line 6-29).

Consider claim 14, and as applied to claim 8, **Ejzak et al.** as modified by **Ahmavaara**. clearly show and disclose a method for providing a packet-based multimedia service to a mobile device in a network, wherein using the signaling context includes using a packet-based session initiation protocol (Column 2 line 37-54).

Claims 15-20, are rejected under **35 U.S.C. 103(a)** as being unpatentable by **Surdila et al** (U.S. Publication # 2002/0110104 A1) in view of **Ejzak et al.** (U.S. Patent Number: 6,721,565 B1).

Consider claim 15, **Surdila et al.** clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, a telecommunications system for

providing a packet-based multimedia service to a mobile station (Paragraph 0004 lines 5-10) (MS) in a wireless network, wherein the service is defined by a telecommunications standard (Paragraph 0009), and wherein the network does not support a packet quality of service (QoS) mechanism specified by the standard, the system comprising: a proxy call session control function (Paragraph 0005 lines 5-15) (P-CSCF); a media gateway connected to the (Paragraph 0005 lines 10-12) P-CSCF; and a plurality of instructions for executing within the network, the instructions for: establishing a packet signaling connection between the MS and the P-CSCF (Paragraph 0008 lines 3-10) establishing a circuit bearer connection between the MS and the media gateway (Paragraph 0005 lines 10-12); transferring signaling information for the multimedia service between the P-CSCF and the media gateway (Paragraph 0008 lines 3-10), and between the P-CSCF and the MS via the packet signaling (Paragraph 0005 lines 5-15) connection in alignment with the standard (Paragraph 0006 lines 3-10). However, **Surdila et al.** did not explicitly mention transferring data for the multimedia service between the media gateway and the MS via the circuit bearer connection in response to the signaling information.

Nevertheless in the same field of endeavor, **Ejzak et al.** clearly show and disclose transferring data for the multimedia service between the media gateway and the MS via the circuit bearer connection in response to the signaling information (Column 11 line 7-22 and figure 1 and elements 122 and 142).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the transferring data for the multimedia service as taught by **Ejzak et al.** and in the method of **Surdila et al.** for the purpose of providing the signaling bearer traffic between the wireless system.

Consider claim 16, Surdila et al. as modified by **Ejzak et al.** clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, the system of claim 15 further comprising a serving call session control function (Paragraph 0007, 0012)(S-CSCF) connected to the P-CSCF and an endpoint, wherein a communication leg between the S-CSCF and the endpoint can be bridged with the circuit bearer connection to form a call session (Paragraph 0005, 0022).

Consider claim 17, Surdila et al. as modified by Ejzak et al.

clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, the system of claim 15 wherein functionality provided by the media gateway and the P-CSCF is combined in a hybrid service gateway (Paragraph 0011) (HSG) multimedia (Paragraph 0014).

Consider claim 18, Surdila et al. as modified by Ejzak et al.

clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, the system of claim 17 further comprising a plurality of media servers connected to the HSG via the P-CSCF (Paragraph 0008).

Consider claim 19, Surdila et al. as modified by Ejzak et al.

clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, the system of claim 15 further comprising: a mobile switching center (Paragraph 0004) (MSC) positioned between the MS and the media gateway, wherein the circuit bearer connection is established between the MS and MSC; and an intelligent gateway positioned between the MSC

and the P-CSCF (Paragraph 0018) wherein the intelligent gateway maps signaling messages (Paragraph 0012) between the P-CSCF (Paragraph 0008) and the MSC (Paragraph 0026).

Consider claim 20, Surdila et al. as modified by **Ejzak et al.** clearly shows and discloses a method for providing a packet-based multimedia service to a mobile device in a network, the system of claim 15 wherein the network is a universal mobile telecommunications system (UMTS) wireless network (Paragraph 0024) and wherein the telecommunications standard is an internet protocol multimedia subsystem (Paragraph 0044) (IMS) standard defined within a third generation partnership project (3GPP) (Paragraph 0031).

Conclusion

THIS ACTION IS MADE FINAL

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street

Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Syed Zaidi whose telephone number is (571) 270-1779. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm. If attempts to reach the Examiner by telephone are Unsuccessful, the Examiner's supervisor, Seema S.Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100. Any inquiry of a general nature or relating to the status of this application or proceeding should be

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directed to the receptionist/ customer service whose telephone
number is (571) 272-2600.

Syed S. Zaidi

Syed Zaidi
S.Z/s.z

DEC 7th, 2007.

Seema S. Rao
SEEMA S. RAO 12/10/07
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